



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/787,004 | 02/24/2004 | Abe Qutub | 61098/2:2 | 3946 |
| 3528 | 7590 | 04/29/2005 | EXAMINER | |
| STOEL RIVES LLP - PDX 900 SW FIFTH AVENUE SUITE 2600 PORTLAND, OR 97204 | | | KRAMER, DEVON C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3683 | |

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/787,004

Applicant(s)

QUTUB ET AL.

Examiner

Devon C Kramer

Art Unit

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/24/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1) Applicant's election with traverse of species 1 in the reply filed on 3/2/05 is acknowledged. The traversal is on the ground(s) that the number of variations depicted in the drawings creates a burdensome search for the examiner. Please note that applicant agrees that the device of figure 5 differs from that of figure 3 in appearance, but functions the same. Note that because a majority of the claims are directed toward the apparatus and not the method, the restriction remains. Applicant's argument with respect to figure 4 is persuasive and the elements and claims associated with figure 4 will be examined.

The requirement is still deemed proper and is therefore made FINAL.

2) Claim 30 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/2/05.

Claim Rejections - 35 USC § 102

3) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4) Claims 1, 3-4, 7-9, 11-17, and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Roy (2678796).

In re claims 1, 13, Roy provides a device capable of acting as a seismic isolator for a structure supporting on a mounting surface (26), the structure including a base (33) having an inner surface facing the mounting surface and an outer surface opposite the inner surface, comprising: a load shaft (21) having opposing first and second ends, the first end adapted to be secured to the mounting surface, and the load shaft sized so that the second end of the load shaft extends beyond the outer surface of the base of the structure; an actuator (11, 17, 19, 34) having a mounting end adapted to be secured to the base and a driver (17, 19, 34) spaced apart from the mounting end; and a resilient element (31, 35, 38) operably interposed between the driver and the second end of the load shaft to allow relative motion between the mounting surface and the structure in the event of an applied external force and to absorb and dissipate energy of such relative motion, thereby attenuating the effect on the structure of the external applied force.

In re claim 3, Roy teaches a tubular actuator stem (11).

IN re claim 4, see figure 1 of Roy.

Art Unit: 3683

IN re claim 7, the nuts (24, 27) enable a preload on the resilient elements.

In re claims 8 and 21, the device of Roy is capable of supporting electrical equipment.

In re claim 9, Roy teaches an arrangement where no part of the isolator extends below the base (33). Please note that Roy meets this limitation as much as the instant application because the instant application has the stud (22) extending below the base.

In re claim 11, see element 14.

In re claim 12, see element 24.

In re claim 14, see resilient element 38, 31, 35; load shaft 21; and actuator 11.

In re claims 15, 17, see figure 1.

In re claim 16, please note that the device is secured to a structure.

In re claim 19, see 17, 19, and 34.

In re claim 20, please note the device can be dismantled via bolts 20, 42.

5) Claims 1-3, 8-9, 11-14, 16 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Hussman (2359915).

In re claims 1-3, 9, 13-14, and 16, Hussman provides a device capable of acting as a seismic isolator for a structure supporting on a mounting surface, the structure including a base (45) having an inner surface facing the mounting surface and an outer surface opposite the inner surface, comprising: a load shaft (47) having opposing first and second ends, the first end adapted to be secured to the mounting surface, and the load shaft sized so that the second end of the load shaft extends beyond the outer

Art Unit: 3683

surface of the base of the structure; an actuator (56, 54, 49) having a mounting end adapted to be secured to the base and a driver (49) spaced apart from the mounting end; and a resilient element (52) operably interposed between the driver and the second end of the load shaft to allow relative motion between the mounting surface and the structure in the event of an applied external force and to absorb and dissipate energy of such relative motion, thereby attenuating the effect on the structure of the external applied force.

In re claims 8 and 21, the device is capable of the recited function.

In re claims 11-12, see 46, 55 and 50.

6) Claims 1-6, 8-9, 13-19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Russold (3608883).

In re claims 1-5, 9, 13-17, Russold provides a device (figure 18) capable of acting as a seismic isolator for a structure supporting on a mounting surface, the structure including a base (adjacent 25) having an inner surface facing the mounting surface and an outer surface opposite the inner surface, comprising: a load shaft (3k) having opposing first and second ends, the first end adapted to be secured to the mounting surface, and the load shaft sized so that the second end of the load shaft extends beyond the outer surface of the base of the structure; an actuator (inner tube between 27 and 28) having a mounting end adapted to be secured to the base and a driver (28, 29) spaced apart from the mounting end; and a resilient element (13k, 14k) operably interposed between the driver and the second end of the load shaft to allow relative

Art Unit: 3683

motion between the mounting surface and the structure in the event of an applied external force and to absorb and dissipate energy of such relative motion, thereby attenuating the effect on the structure of the external applied force.

In re claims 6 and 18-19, see 25 and 30.

In re claims 8 and 21, the device is capable of the recited function.

In re claim 11, see element 26.

Claim Rejections - 35 USC § 103

7) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8) Claims 10 and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy (2678796) in view of Wolf et al (3973078).

Roy teaches all of the limitations in the claims as cited above, but lack the teaching of a mounting stud.

Wolf et al teaches a mounting stud in figure 11. Note the top and bottom portions are attached to structure or a base using a threaded stud.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have mounted the isolators of Roy using a mounting stud as taught by Wolf et al merely because it is a known secure means to mount a device to a ground structure.

9) Claims 10 and 22-25, 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hussman (2359915) in view of Wolf et al (3973078).

Hussman teach all of the limitations in the claims as cited above, but lack the teaching of a mounting stud.

Wolf et al teaches a mounting stud in figure 11. Note the top and bottom portions are attached to structure or a base using a threaded stud.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have mounted the isolators of Hussman using a mounting stud as taught by Wolf et al merely because it is a known secure means to mount a device to a ground structure.

10) Claims 10 and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russold (3608883) in view of Wolf et al (3973078).

Russold teach all of the limitations in the claims as cited above, but lack the teaching of a mounting stud.

Wolf et al teaches a mounting stud in figure 11. Note the top and bottom portions are attached to structure or a base using a threaded stud.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have mounted the isolators of Russold using a mounting stud as taught by Wolf et al merely because it is a known secure means to mount a device to a ground structure.

Art Unit: 3683

Conclusion

11) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stiefel et al, Jansen, Kemeny, and Corcoran et al all provide isolators similar to the instant application.

12) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devon C Kramer whose telephone number is 571-272-7118. The examiner can normally be reached on Mon-Fri 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Devon C Kramer
Examiner
Art Unit 3683

DK

DEVON C. KRAMER
PATENT EXAMINER

Devon Kramer
4/28/05